

### **REMARKS**

Claims 1, 28, 41, 42, 46, 49 and 51 have been amended.

The abstract has been amended in accordance with the Office Action.

The specification has been amended to identify all parent applications by serial number as well as patent number. Priority to these documents has been claimed previously; the amendment simply provides the serial number for each of those documents in addition to the patent number previously provided.

Replacement drawing sheet 58 is submitted with this document in response to the Office Action.

The Office Action objects to claims 28 and 46 as including the term “moveable”, and requests a change to the term “movable.” Although Webster’s New World Dictionary, Second College Edition, shows that both spellings of the word are correct, the spelling has been changed in order to further prosecution of this application.

Claim 50 introduces a workpiece flap, and as a result the use of “the” or “said” in the context of such an introduction, as suggested by the Office Action, is inappropriate.

To the extent that it is not necessary to address the rejection of dependent claims by the Office Action in order to provide a complete response, Applicants’ choice not to discuss such rejections is not, and cannot be interpreted as, acquiescence by the Applicants to such rejections, nor does it limit or can it be construed during prosecution of this patent application or in any later administrative or judicial action to limit the scope of any claims that may eventually issue in this patent application or any patent application claiming priority to this one.

35 U.S.C. §103

MPEP 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 1438 (Fed. Cir. 1991) (emphasis added).

Claims 1-30

Amended claim 1 claims “[a] system for preparing a graft vessel for anastomosis to a target vessel, where the anastomosis has an anastomosis length, the system comprising: an anastomosis tool configured to connect the graft vessel and the target vessel upon actuation; and a transfer clamp including two arms movable relative to one another to grasp the graft vessel, said transfer clamp configured to be attached to said anastomosis tool to place the grasp vessel on said anastomosis tool and to be detached from said anastomosis tool before said actuation, wherein at least one said arm comprises at least one element having an edge, wherein the length of said edge is related to the anastomosis length.”

In contrast, neither U.S. Patent No. 6,187,019 to Stefanchik et. al. (“Stefanchik ‘019”) nor U.S. Patent No. 6,036,700 to Stefanchik et. al. (“Stefanchik ‘700”) teach or suggest all of the limitations of amended claim 1. Even if the clip 80 of Stefanchik ‘019 is considered to be analogous to the claimed transfer clamp, which is not admitted, the clip 80 is connected to the anastomosis tool during actuation of that tool. The clip 80 snaps onto the cassette 60 of the anastomosis tool before its actuation. (Stefanchik ‘019, col. 6, lines 44-49; Figures 8-9). Stefanchik ‘019 performs anastomosis by suturing tissue junctions with the use of spiral needles. (Stefanchik ‘019; *e.g.*, col. 9, lines 12-14; Figures 15-16, 18-19, 21). The “tissue junctions must be held together firmly along their entire

length as the spiral needles advance. This is accomplished by maintaining the close, parallel alignment of the first and second prongs, 82 and 84, of the tissue clip 80.” (Stefanchik ‘019; col. 9, lines 14-19) (emphasis added). Thus, the clip 80 is required to be attached to the cassette 60 of the anastomosis tool in order for it to operate. This requirement is directly opposite to the requirement of claim 1 of an “anastomosis tool configured to connect the graft vessel and the target vessel upon actuation...and a transfer clamp...configured...to be detached from said anastomosis tool before said actuation.” (emphasis added).

Further, by requiring the attachment of the clip 80 to the cassette 60 during actuation, Stefanchik ‘019 teaches away from a “transfer clamp configured...to be detached from said anastomosis tool before said actuation.” (emphasis added).

Turning to Stefanchik ‘700, the Office Action does not assert that Stefanchik ‘700 teaches or suggests a transfer clamp, and indeed Stefanchik ‘700 does not teach or suggest a transfer clamp. Stefanchik ‘700 instead simply describes a tool for facilitating suturing. Nowhere does Stefanchik ‘700 teach or suggest an “anastomosis tool configured to connect the graft vessel and the target vessel upon actuation...and a transfer clamp,” much less a transfer clamp “configured...to be detached from said anastomosis tool,” whether before or after actuation of that anastomosis tool.

Thus, neither Stefanchik ‘019 nor Stefanchik ‘700, alone or together, teaches or suggests all of the limitations of amended claim 1, and claim 1 is believed to be in condition for allowance. Claims 2-30 depend from claim 1, and are thus believed to be in condition for allowance as well under MPEP 608.01(n)(III).

#### Claims 41-48

Amended claim 41 claims “[a] system for performing anastomosis between a graft vessel and a target vessel, where the anastomosis has an anastomosis length, the system comprising: a tissue effector comprising an anvil, and a staple holder movable relative to said anvil; and a transfer clamp

connectable to said tissue effector, said transfer clamp including two arms movable to one another, wherein each said arm includes a substantially planar surface with an edge, wherein the length of each said edge is related to the anastomosis length, and wherein said surfaces are substantially opposed to one another.”

First, U.S. Publication No. 2001/0023353 to Vargas et. al. (“Vargas”) is not available art. U.S. Publication No. 2001/0023353 has serial no. 09/363,255, and issued as U.S. Patent No. 6,391,038. That patent is the great-grandparent of this application, as set forth on the first page of this application. Under MPEP 706.02(V)(B), if claim 41 is supported by its parent to an extent that the parent has prior art effect, then it is supported by the disclosure of the present application to the point that its parent is not prior art.

Second, even if the clip 80 of Stefanchik ‘019 is considered to be analogous to the claimed transfer clamp, which is not admitted, the clip 80 has two needlelike, tubular prongs 82, 84. (Stefanchik ‘019; e.g., col. 5, lines 46-65; Figures 3-6). Claim 41 requires that “each...arm includes a substantially planar surface with an edge.” However, neither of the prongs 82, 84 of Stefanchik ‘019 “includes a substantially planar surface,” much less both of the prongs 82, 84.

Thus, Stefanchik ‘019 does not teach or suggest all of the limitations of amended claim 41, and claim 41 is believed to be in condition for allowance. Claims 42-48 depend from claim 41, and are thus believed to be in condition for allowance as well under MPEP 608.01(n)(III).

#### Claims 49-53

Amended claim 49 claims “[a] system for performing anastomosis between a graft vessel and a target vessel, comprising: a tissue effector comprising an anvil, and a staple holder movable relative to said anvil; and a mechanism configured to register the graft vessel relative to said tissue effector prior to actuation thereof, and configured to be independent of said tissue effector during actuation thereof.”

First, U.S. Publication No. 2001/0023353 to Vargas et. al. (“Vargas”) is not available art, for the reasons set forth about with regard to claim 41.

Second, even if the clip 80 of Stefanchik ‘019 is considered to be analogous to the claimed transfer clamp, which is not admitted, the clip 80 is connected to the anastomosis tool during actuation of that tool. The argument set forth above with regard to claim 1 applies equally here. The clip 80 of Stefanchik ‘019 is required to be attached to the cassette 60 of the anastomosis tool in order for it to operate. This requirement is directly opposite to the requirement of claim 49 of a “mechanism configured to register the graft vessel relative to said tissue effector prior to actuation thereof, and configured to be independent of said tissue effector during actuation thereof.” (emphasis added).

Further, by requiring the attachment of the clip 80 to the cassette 60 during actuation, Stefanchik ‘019 teaches away from a “mechanism...configured to be independent of said tissue effector during actuation thereof.” (emphasis added).

Thus, Stefanchik ‘019 does not teach or suggest all of the limitations of amended claim 49, and claim 49 is believed to be in condition for allowance. Claims 50-53 depend from claim 49, and are thus believed to be in condition for allowance as well under MPEP 608.01(n)(III).

#### **REQUEST FOR ALLOWANCE**

Allowance of the pending claims is respectfully solicited. Please contact the undersigned if there are any questions.

Respectfully submitted,

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